

ESTTA Tracking number: **ESTTA583078**

Filing date: **01/22/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Mars, Incorporated
Granted to Date of previous extension	01/22/2014
Address	6885 Elm Street McLean, VA 22101 UNITED STATES

Attorney information	Ross Q. Panko Arent Fox LLP 1717 K Street NW Washington, DC 20036 UNITED STATES ross.panko@arentfox.com, tmdocket@arentfox.com, marsdocket@arentfox.com, sherwin.loni@arentfox.com
----------------------	--

### Applicant Information

Application No	85979991	Publication date	09/24/2013
Opposition Filing Date	01/22/2014	Opposition Period Ends	01/22/2014
Applicant	Empire Resorts, Inc. 204 Rt. 17B Monticello, NY 12701 GERMANY		

### Goods/Services Affected by Opposition

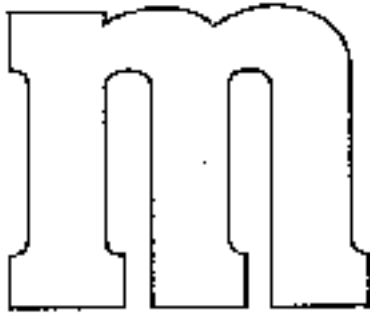
Class 030. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Candy; confectionary items, namely, chocolate confections; vanilla confections; butterscotch confections; toffee confections; frozen confectionary and fondants

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	418332	Application Date	09/16/1944
Registration Date	12/18/1945	Foreign Priority Date	NONE

Word Mark	M
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1921/11/01 First Use In Commerce: 1921/11/01 CANDY


U.S. Registration No.	3336485	Application Date	09/14/2005
Registration Date	11/13/2007	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of a lentil design with the letter "M" on it.		
Goods/Services	Class 030. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Frozen confections, namely, ice cream and ice cream cakes		

U.S. Registration No.	3352030	Application Date	10/11/2005
Registration Date	12/11/2007	Foreign Priority Date	NONE
Word Mark	M		

Design Mark	
Description of Mark	The mark consists of the color green applied to the surface of a candy piece with a white stylized letter "M" depicted in the center.
Goods/Services	Class 030. First use: First Use: 1941/00/00 First Use In Commerce: 1941/00/00 Confectionery, namely, candy


U.S. Registration No.	3356124	Application Date	10/14/2005
Registration Date	12/18/2007	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of the color orange applied to the surface of a candy piece with a white stylized letter "M" depicted in the center.		
Goods/Services	Class 030. First use: First Use: 1941/00/00 First Use In Commerce: 1941/00/00 Confectionery, namely, candy		


U.S. Registration No.	3365663	Application Date	10/11/2005
Registration Date	01/08/2008	Foreign Priority Date	NONE
Word Mark	M		

Design Mark	
Description of Mark	The mark consists of the color red applied to the surface of a candy piece with a white stylized letter "M" depicted in the center.
Goods/Services	Class 030. First use: First Use: 1941/00/00 First Use In Commerce: 1941/00/00 Confectionery, namely, candy


U.S. Registration No.	3435971	Application Date	10/11/2005
Registration Date	05/27/2008	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of the color yellow applied to the surface of a candy piece with a white stylized letter "m" depicted in the center.		
Goods/Services	Class 030. First use: First Use: 1941/00/00 First Use In Commerce: 1941/00/00 Confectionery, namely, candy		


U.S. Registration No.	3485902	Application Date	05/18/2007
Registration Date	08/12/2008	Foreign Priority Date	NONE
Word Mark	THERE'S AN M IN EVERYONE.		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2007/08/00 First Use In Commerce: 2007/08/00 confectionery, namely, candy


U.S. Registration No.	4097994	Application Date	12/20/2010
Registration Date	02/14/2012	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of a stylized Letter "M" in white applied to the surface of an ice cream bar, with the color blue applied to the surface of the ice cream bar. The matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.		
Goods/Services	Class 030. First use: First Use: 2008/02/00 First Use In Commerce: 2008/02/00 Ice cream bars		


U.S. Registration No.	4097993	Application Date	12/20/2010
Registration Date	02/14/2012	Foreign Priority Date	NONE
Word Mark	M		

Design Mark	
Description of Mark	The mark consists of a stylized Letter "M" in white applied to the surface of an ice cream bar, with the color green applied to the surface of the ice cream bar. The matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.
Goods/Services	Class 030. First use: First Use: 2008/02/00 First Use In Commerce: 2008/02/00 Ice cream bars


U.S. Registration No.	4101119	Application Date	12/20/2010
Registration Date	02/21/2012	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of a stylized Letter "M" in white applied to the surface of an ice cream bar, with the color red applied to the surface of the ice cream bar. The matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark.		
Goods/Services	Class 030. First use: First Use: 2008/02/00 First Use In Commerce: 2008/02/00 Ice cream bars		

U.S. Registration No.	4298322	Application Date	10/10/2012
Registration Date	03/05/2013	Foreign Priority Date	NONE
Word Mark	MY M M&M'S		

Design Mark			
Description of Mark	The mark consists of a large and a small circle side by side with the larger circle on the left slightly covering the smaller one. The word "MY" in stylized lettering is depicted in the larger circle and the letter "M" in stylized lettering is depicted in the smaller circle. Below and slightly covering the circles are the letters "M&M'S" in stylized lettering.		
Goods/Services	Class 030. First use: First Use: 2012/07/24 First Use In Commerce: 2012/07/24 Candy		

U.S. Registration No.	3348192	Application Date	10/11/2005
Registration Date	12/04/2007	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of the color blue applied to the surface of a candy piece with a white stylized letter "M" depicted in the center.		
Goods/Services	Class 030. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Confectionery, namely, candy		

U.S. Registration No.	3352029	Application Date	10/11/2005
Registration Date	12/11/2007	Foreign Priority Date	NONE
Word Mark	M		

Design Mark	
Description of Mark	The mark consists of the color brown applied to the surface of a candy piece with a white stylized letter "M" depicted in the center.
Goods/Services	Class 030. First use: First Use: 1941/00/00 First Use In Commerce: 1941/00/00 Confectionery, namely, candy

Attachments	71474291#TMSN.gif( bytes ) 78712907#TMSN.jpeg( bytes ) 78731048#TMSN.jpeg( bytes ) 78733271#TMSN.jpeg( bytes ) 78731112#TMSN.jpeg( bytes ) 78731099#TMSN.jpeg( bytes ) 77185023#TMSN.jpeg( bytes ) 85202039#TMSN.jpeg( bytes ) 85202022#TMSN.jpeg( bytes ) 85202057#TMSN.jpeg( bytes ) 85750012#TMSN.jpeg( bytes ) 78731024#TMSN.jpeg( bytes ) 78730956#TMSN.jpeg( bytes ) Empire Resorts M IN CIRCLE Notice of Opposition.pdf(84659 bytes )
-------------	---

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Loni J. Sherwin/
Name	Loni J. Sherwin
Date	01/22/2014



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 85/979,991 for the mark M & Design, filed September 24, 2012 and published September 24, 2013

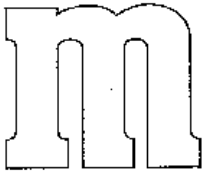
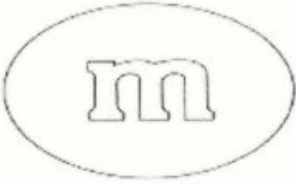





MARS, INCORPORATED	)	
	)	
Opposer,	)	Serial No. 85/979,991
	)	
v.	)	Opposition No. _____
	)	
EMPIRE RESORTS, INC.,	)	
	)	
Applicant.	)	
	)	





**NOTICE OF OPPOSITION**

Mars, Incorporated (“Opposer”), a corporation duly organized and existing under the laws of the State of Delaware, having a place of business at 6885 Elm Street, McLean, Virginia 22101, believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/979,991 and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to a family of famous marks containing or comprised of a stylized letter “M” within a circle or displayed on a circular candy lentil (“M in Circle Mark”) and a stylized letter “M” in isolation (“Stylized M Mark”) (collectively, the “M Marks”), which Opposer uses in connection with confectionery and other food products.
2. Opposer’s rights in the M Marks have been recognized by the United States Patent and Trademark Office (“USPTO”), which has issued numerous federal registrations to Opposer for its M Marks, including the following:

Trademark	Registration No.	Registration Date	Goods
	418,332	December 18, 1945	Candy.
	3,336,485	November 13, 2007	Frozen confections, namely, ice cream and ice cream cakes.
	3,348,192	December 4, 2007	Confectionery, namely, candy.
	3,352,030	December 11, 2007	Confectionery, namely, candy.
	3,352,029	December 11, 2007	Confectionery, namely, candy.
	3,356,124	December 18, 2007	Confectionery, namely, candy.
	3,365,663	January 8, 2008	Confectionery, namely, candy.

Trademark	Registration No.	Registration Date	Goods
	3,435,971	May 27, 2008	Confectionery, namely, candy.
There's an  in everyone.	3,485,902	August 12, 2008	Confectionery, namely, candy.
	4,097,994	February 14, 2012	Ice cream bars.
	4,097,993	February 14, 2012	Ice cream bars.
	4,101,119	February 21, 2012	Ice cream bars.
	4,298,322	March 5, 2013	Candy.

3. Opposer's registrations are valid and subsisting, and Registration Nos. 418,332; 3,336,485; 3,348,192; 3,352,030; 3,352,029; 3,356,124; and 3,365,663 are incontestable. These registrations provide *prima facie* evidence, and the incontestable registrations provide conclusive evidence, of Opposer's ownership of the M Marks, of the validity of the marks, and of Opposer's exclusive right to use the marks in commerce.

4. Opposer has used its M Marks in interstate commerce continuously since at least as early as 1941. Since then, Opposer has extensively used, advertised, and promoted in interstate commerce the M Marks in connection with confectionery and other food products, including its famous M&M'S® candies and other items.

5. Opposer has expended substantially large sums of money to advertise and promote its products under the M Marks in television, print, and other forms of advertising.

6. As a result of such extensive use, advertising, and promotion, Opposer's M Marks have become famous as distinctive indicators of the origin of Opposer's goods, and the marks have become extremely valuable symbols of Opposer's goodwill.

7. Notwithstanding Opposer's prior established rights in the M Marks, Applicant filed an application with the USPTO on September 24, 2012 for a mark comprised of a stylized letter "M" within a circle (Ser. No. 85/979,991) for "Candy; confectionary items, namely, chocolate confections; vanilla confections; butterscotch confections; toffee confections; frozen confectionary and fondants."

8. Upon information and belief, Applicant knew or had reason to know of Opposer's prior rights in the M Marks when Applicant filed its application.

### **Count I -- Likelihood of Confusion - §2(d)**

9. The mark that Applicant seeks to register so closely resembles the M Marks that the use and registration thereof is likely to cause confusion, mistake, and deception as to the

source or origin of Applicant's goods and will injure and damage Opposer and the goodwill and reputation symbolized by the M Marks. Applicant's alleged mark is virtually identical to Opposer's M in Circle Mark since Applicant's alleged mark, like Opposer's M in Circle Mark, displays a stylized letter "M" within a circle. Any minor differences between Applicant's alleged mark and Opposer's marks are not likely to be perceived by the consuming public given the undeniable similarities between the marks.

10. Applicant's goods are identical or so closely related to Opposer's goods such that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer, or that Applicant is in some way connected or affiliated with, or approved or sponsored by, Opposer, all to Opposer's irreparable damage.

11. Likelihood of confusion is enhanced by the fame of Opposer's M Marks, such that consumers will assume erroneously that Applicant's virtually identical mark and the goods offered thereunder are sold, approved, or endorsed by Opposer.

12. Likelihood of confusion is enhanced by the fact that purchasers of Applicant's goods are prospective purchasers of Opposer's goods, and vice versa, and because the parties' goods are sold through the same channels of trade.

#### **Count II -- Dilution - §43(c)**

13. Opposer's inherently distinctive M Marks have been widely used and extensively advertised in the United States and internationally for many years.

14. A substantial volume of confectionery and other food products have been sold under Opposer's M Marks throughout the United States and around the world.

15. The extent of actual consumer recognition of Opposer's M Marks is substantial.

16. Because of the extensive use and advertising of Opposer's M Marks, the substantial sales of products under the M Marks, and the actual recognition of the M Marks by

the consuming public, Opposer's M Marks have become famous as distinctive symbols of Opposer's goodwill.

17. Applicant has filed for, and is making or intends to make unauthorized use in commerce of, a mark that is nearly identical to one or more of Opposer's famous M Marks.

18. Applicant's use began, or will begin, long after Opposer's M Marks became famous.

19. Applicant's alleged mark is likely to cause, and will cause, dilution of the distinctive qualities of Opposer's M Marks by blurring and tarnishment.

20. Use or registration of Applicant's alleged mark will lessen the capacity of Opposer's famous M Marks to identify and distinguish Opposer's goods.

21. Likelihood of dilution is enhanced by the fact that Applicant's alleged mark is nearly identical in appearance, sound, and overall commercial impression to Opposer's M Marks or the dominant portions thereof.

22. Applicant's use or registration of Applicant's alleged mark will deprive Opposer of the ability to protect its reputation, persona, and goodwill.

23. Applicant's use or registration of Applicant's alleged mark will tarnish and blur the goodwill symbolized by Opposer's M Marks.

24. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by the fact that prospective customers who encounter defects in the quality of Applicant's goods and services will attribute those defects to Opposer, and this will tarnish Opposer's reputation and goodwill.

25. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark, and registration should be refused.

WHEREFORE, Opposer respectfully requests that the registration sought by Applicant be refused and that this Opposition be sustained.

MARS, INCORPORATED

Dated: January 22, 2014

By: /Loni J. Sherwin/

Cristina A. Carvalho

Ross Q. Panko

Loni J. Sherwin

Arent Fox LLP

1717 K St. NW

Washington, D.C. 20036

(202) 857-6000

*Attorneys for Opposer*

*Mars, Incorporated*

**CERTIFICATE OF SERVICE**

It is hereby certified that the foregoing **NOTICE OF OPPOSITION** (re: Serial No. 85/979,991) has been served on Applicant's Attorney of Record Charles N. Quinn at Fox Rothschild LLP, 2000 Market Street, 20<sup>th</sup> Floor, Philadelphia, Pennsylvania 19103, by first-class mail, postage prepaid, this 22nd day of January, 2014.

\_\_\_\_\_  
/Loni J. Sherwin/  
Loni J. Sherwin, Esq.  
Arent Fox LLP  
1717 K St. NW  
Washington, DC 20036